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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,273	10/15/2001	Chrisotpher John Robert Thomas	13101/48801	4447

7590 03/22/2006
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EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,273

Applicant(s)

THOMAS ET AL.

Examiner

Cynthia Collins

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

Applicant's submission filed on December 27, 2005 has been entered.

Claims 1-54 are cancelled.

Claims 55-66 are newly added.

Claims 55-66 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections, not set forth below have been withdrawn.

Claim Rejections - 35 USC § 102

Claims 55 and 58-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Maddaloni et al. (Transgenic Research, 1997, Vol. 6, No. 6, pages 393-402), for the reasons of record.

Applicants' arguments filed December 27, 2005 have been fully considered but they are not persuasive.

Applicants point out that they have amended the claims to indicate that the method encompasses the selective expression of a ribosome inactivating protein at the target site for induction of plant cell death at that target site, and maintain that since Maddaloni fails to describe the selective expression of a ribosome inactivating protein to a specific location within the plant body, i.e., a target site, for induction of plant cell death at that location, as required by

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the amended claims, the claimed invention simply cannot be anticipated by Maddaloni. (reply pages 8-9)

Applicants' arguments are unpersuasive, as Maddaloni et al. teach the selective expression of a ribosome inactivating protein to a specific location within the plant body, i.e., a wounding target site (pages 394-395; page 396 Figure 1; page 397 Figure 3). While Maddaloni et al. are silent with respect to the induction of plant cell death at that location, Maddaloni et al. need not explicitly teach the induction of plant cell death at that location to anticipate the rejected claims, as the induction of plant cell death at that location is the inherent result of practicing the claimed method. Because the method taught by Maddaloni et al. utilizes the exact same materials and method steps as are recited in the rejected claims, the method taught by Maddaloni et al. is presumed to produce the same inherent result as the claimed method, including results not explicitly taught or recognized by Maddaloni et al.

See *ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993), in which the Board rejected claims directed to a method for protecting a plant from pathogenic nematodes by inoculating the plant with *Pseudomonas cepacia* type Wisconsin 526 bacteria under 35 USC 102 as being anticipated by Dart et al. , whose U.S. patent disclosed a method for protecting a plant from fungal disease by inoculating the plant with *Pseudomonas cepacia* type Wisconsin 526 bacteria. Although Dart et al. was silent with respect to nematode inhibition, the Board concluded that Dart et al. anticipated the rejected claims because nematode inhibition was an inherent property of the bacteria.

Claim Rejections - 35 USC § 103

Claims 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maddaloni et al. (Transgenic Research, 1997, Vol. 6, No. 6, pages 393-402) in view of Hey et al. (Plant Physiology, 1995, Vol. 107, pages 1323-1332) and Boston et al. (US 5,332,808 issued July 26, 1994, Applicant's IDS), for the reasons of record.

Applicants' arguments filed December 27, 2005 have been fully considered but they are not persuasive.

Applicants point out that they have amended the claims to indicate that the method encompasses the selective expression of a ribosome inactivating protein at the target site for induction of plant cell death at that target site, and maintain that since Maddaloni fails to describe the selective expression of a ribosome inactivating protein to a specific location within the plant body, i.e., a target site, for induction of plant cell death at that location, as required by the amended claims, the claimed invention simply cannot be rendered obvious. With regard to the Hey and Boston references, Applicants assert that neither reference makes up for the deficiencies of Maddaloni, as either reference discloses, teaches, or suggests the use of target tissue selective localized expression of a ribosome inactivating protein for induction of plant cell death. (reply pages 9-10)

Applicants' arguments are unpersuasive, as Maddaloni et al. teach the selective expression of a ribosome inactivating protein to a specific location within the plant body, i.e., a wounding target site (pages 394-395; page 396 Figure 1; page 397 Figure 3). While Maddaloni et al. are silent with respect to the induction of plant cell death at that location, Maddaloni et al. need not explicitly teach the induction of plant cell death at that location to anticipate the rejected

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claims, as the induction of plant cell death at that location is the inherent result of practicing the claimed method. Because the method taught by Maddaloni et al. utilizes the exact same materials and method steps as are recited in the rejected claims, the method taught by Maddaloni et al. is presumed to produce the same inherent result as the claimed method, including results not explicitly taught or recognized by Maddaloni et al.

With regard to the Hey and Boston references, the Examiner maintains that neither reference need disclose, teach, or suggest the use of target tissue selective localized expression of a ribosome inactivating protein for induction of plant cell death, as Hey et al. and Boston et al. were not cited for their teachings with respect to localized expression of a ribosome inactivating protein. Hey et al. was cited for teaching a biologically active recombinant mature maize RIP comprising an α domain and a β domain arranged contiguously, and Boston et al. was cited for teaching the use of a nos terminator in a plant expression construct.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Remarks

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins
Primary Examiner
Art Unit 1638



3/16/06

CC